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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.                      | CONFIRMATION NO. |
|---|-------------|----------------------|--|------------------|
| 10/729,959  | 12/09/2003  | Osamu Tachizawa      | 246310US0                                | 2738             |
| 22850   | 7590        | 04/06/2007           |  |                  |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | EXAMINER<br>CHANNAVAJALA, LAKSHMI SARADA |                  |
|   |             |                      | ART UNIT<br>1615                         | PAPER NUMBER     |

| SHORTENED STATUTORY PERIOD OF RESPONSE | NOTIFICATION DATE | DELIVERY MODE |
|--|-------------------|---------------|
| 3 MONTHS                               | 04/06/2007        | ELECTRONIC    |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/06/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

**Application No.**

10/729,959

**Applicant(s)**

TACHIZAWA ET AL.

**Examiner**

Lakshmi S. Channavajjala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/9/04; 10/25/04; 12/19/06</u> . | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

Receipt of IDS dated 3-9-04, 10-25-04 and 12-19-06 is acknowledged.

Claims 1-5 are pending in the instant application.

The use of the trademark "Kalcol 2470" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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1. Claims 1-5 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,914,038 ('038) in view of EP 190010 (hereafter EP10, submitted on PTO-1449). '038 claims hair cleansing compositions comprising water, anionic sulfate type surfactant, cationic gum (reads on instant cationic polymer), silicone etc. The claims of '038 do not describe the actual sulfate surfactant and generally teaches sulfate-type surfactant. However, under the definition of "sulfate" surfactants, '0238 teaches both alkyl ether sulfates and also alkyl ether sulfates containing polyethylene oxide groups (having the same formula of instant claim 1). Thus, the claims of '038 are generic to sulfate surfactants.

EP10 teaches shampoo compositions comprising anionic surfactant, silicone, gums, water, pearlescent agent etc (see examples). Among the surfactants, EP teaches alkyl ether sulfates containing polyethylene oxide groups (page 3, L 20-page 4, L17) and an average 3 moles of ethylene oxide per alcohol. Among the preferred compounds, EP10 teaches upto 30% of the sulfates having 0 moles of ethoxylation (reads on instant  $n=0$ ) and 45% -90% having  $n=1-4$ ; 10-25% having  $n=4-8$  and 0.1% to 15% having  $n \geq 18$ . While the percentages described by EP10 appears to be different from those claimed, an overall percentage or distribution of ethylene oxide groups falls within the claimed ranges. Further, EP10 teaches a mixture or a combination of sulfate surfactants with ethylene oxide groups and alkyl ether sulfate (also present in the example compositions of '038). It would have been obvious for one of an ordinary skill in the art at the time of the instant invention to incorporate the anionic surfactants of EP10 i.e., alkyl sulfates or alkyl ether sulfate with the above range or percentage of

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ethoxylation or a mixture of both, in the cleansing composition of '038 because EP10 suggests that the alkyl ether sulfates containing polyethylene oxide groups alone or in combination with alkyl ether sulfates improve the silicone deposition on hair and also overcome the problems associated with the compatibility of anionic surfactant and conditioning agents in the cleansing compositions.

Claims 1-5 are directed to an invention not patentably distinct from claims 1-17 of commonly assigned US 6,914,038. See the above explanation that both sets of claims are of same scope.

The U.S. Patent and Trademark Office normally will not institute interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 6,914,038, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

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2. Claims 1-5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 11/313,740. Although the conflicting claims are not identical, they are not patentably distinct from each other because both instant as well as the co-pending claims are directed aqueous hair cleansing composition comprising exactly the same sulfate surfactant. While instant claims broadly recite other components such as silicones, cationic polymers etc., and application no.11/313,740 recites the specific components. Thus, the claims of the co-pending claims anticipate instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 190 010 (hereafter EP 10).

EP10 teaches shampoo compositions comprising anionic surfactant, silicone, gums, water, pearlescent agent etc (see examples). Among the surfactants, EP teaches alkyl ether sulfates containing polyethylene oxide groups (page 3, L 20-page 4, L17)

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and an average 3 moles of ethylene oxide per alcohol. Among the preferred compounds, EP10 teaches upto 30% of the sulfates having 0 moles of ethoxylation (reads on instant  $n=0$ ) and 45% -90% having  $n=1-4$ ; 10-25% having  $n=4-8$  and 0.1% to 15% having  $n \geq 18$ . While the percentages described by EP10 appears to be different from those claimed, an overall percentage or distribution of ethylene oxide groups falls within the claimed ranges. Further, EP10 teaches a mixture or a combination of sulfate surfactants with ethylene oxide groups and alkyl ether sulfate. Therefore, EP anticipates instant claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being obvious over US 6,914,038 in view of EP 190010 (hereafter EP10, submitted on PTO-1449).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an

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invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

'038 claims and teaches hair cleansing compositions comprising water, anionic sulfate type surfactant, cationic gum (reads on instant cationic polymer), silicone etc. The claims of '038 do not describe the actual sulfate surfactant and generally teaches sulfate-type surfactant. However, under the definition of "sulfate" surfactants, '0238 teaches both alkyl ether sulfates and also alkyl ether sulfates containing polyethylene oxide groups (having the same formula of instant claim 1, see col. 2 and examples of '038). '038 do not teach the claimed percentages of ethylene oxide units in the surfactant.

EP10, discussed above, teaches the claimed alkyl sulfate surfactant with the percentages of ethylene oxide in the claimed range. Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to incorporate the anionic surfactants of EP10 i.e., alkyl sulfates or alkyl ether sulfate with the above range or percentage of ethoxylation or a mixture of both, in the cleansing



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composition of '038 because EP10 suggests that the alkyl ether sulfates containing polyethylene oxide groups alone or in combination with alkyl ether sulfates improve the silicone deposition on hair and also overcome the problems associated with the compatibility of anionic surfactant and conditioning agents in the cleansing compositions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 7.00 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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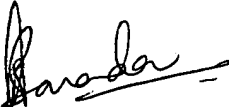
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AU 1615  
March 29, 2007

  
**LAKSHMI S. CHANNAVAJJALA**  
**PRIMARY EXAMINER**